

REMARKS

The present paper is in response to the Final Office Action dated May 8, 2007. Claims 41-54 are pending in this application. By the present amendments, applicants amend claims 41, 46, and 49. The Applicants respectfully submit that the pending claims 41-54 are in condition for allowance in view of the amendments and the following supporting remarks.

A. Claim Rejections under 35 U.S.C. § 103(a)**(1) Schmidt (U.S. Patent No. 6,208,872) and in view of Irvin (U.S. Patent No. 6,556,819)**

The Examiner rejects claims 41-54 as being unpatentable over Schmidt (United States Patent No. 6,208,872) in view of Irvin (United States Patent No. 6,556,819). In light of the arguments contained herein, the Applicants respectfully request that this rejection be withdrawn.

With regard to independent claim 41, 46, and 49 the Examiner states that Schmidt teaches all of the elements of the claims, except utilizing a GPS functional device contained within the wireless communication device. The Examiner further states that Irvin teaches this limitation. The Examiner states that the combination of Schmidt and Irvin makes the claims obvious. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the cited references would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the cited reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the cited references, and not based on Applicant's disclosure.

1. Suggestion or Motivation to Combine

The subject matter of the claims is restricting communications between wireless communication devices. The Schmidt reference addresses checking to ensure that placing and receiving calls is allowed during roaming, before a call is placed by or received by a potentially roaming wireless communication device. The Irvin reference is directed to utilizing a position sensing system to determine when a device is in a safe zone. (See, Irvin, Abstract).

There are very significant differences between the claims 41, 46, and 49 and handling communications while a device is potentially roaming, as in Schmidt, and utilizing a GPS to determine whether a device is in a safe zone, as in Irvin. Namely, neither cited reference taken alone or in combination suggests an implementation of restricting communications between wireless communication devices as is presently claimed, irrespective of the physical location of the devices.

For example, whenever a wireless communication device (i.e., mobile station) in Schmidt places an outgoing call or receives an incoming call, a determinator component first checks to see if the mobile station is roaming by checking to see "if the system ID

number of the cellular network in which the mobile station is currently located (the "current system ID number"), matches the system ID number of the mobile station's home system (the "home system ID number"), which is conventionally stored in the mobile station" and then if the wireless communication device is determined to be roaming, allowing the outgoing call to be placed or incoming call to be received only if the "ROEF-2 is in a state "1" permitting calls" to be placed or received while roaming. (See Schmidt, Column 6, lines 15-16, 27-38; Column 7, line 58 – Column 8, lines 44-59).

Even if Irvin uses a location identifying system and it is combined with Schmidt, for example, to determine whether the device is roaming (i.e., away from its base station geographically), the proposed combination restricts calls in a manner that is completely dependent on the physical location of the device.

There is no suggestion or motivation from Schmidt or Irvin to utilize a controller to determine "a parameter associated with the geographic characteristic stored in the memory indicates that the geographic characteristic is an approved geographic characteristic, the parameter being independent of the physical location of the wireless communication device." (See claim 41, for example. Similar language is found in independent claims 46 and 49).

The cited references do not suggest this limitation because the determination in Schmidt is based upon a state machine (or ROEF). The state machine might indicate that the call is allowed (e.g., not roaming) or the call is not allowed (e.g., roaming). In such a case, a parameter could not be stored in memory in association with the geographic characteristic that is independent of the physical location of the device,

because the ROEF is a location dependent state machine. Therefore, a person skilled in the art would not be motivated to store the ROEF in memory as is presently claimed because there is a chance that the parameter would give incorrect results. Moreover, the use of the ROEF would suggest to someone having skill in the art that location dependent information should be stored in memory. The present claims are directed to a parameter that is not indicative of any location, either of the device or of the caller to the device.

Thus, the combination of Schmidt and Irvin teaches away from the present claims. For example, if the combination of Schmidt and Irvin taught the "parameter" associated with the "geographic characteristic" in memory, the parameter would indicate one of two things, either the call is allowed or it is not allowed. If the parameter says the call was allowed and in Schmidt, the device user traveled far from their home station, then the call would be allowed while roaming.

The present result is contrary to the nature of Schmidt since Schmidt teaches that the state machine would change when roaming occurs and the call would not be allowed. If Schmidt could be combined with Irvin then, a person having ordinary skill in the art would be motivated to store a parameter that is location dependent. Therefore, the ROEF cannot motivate a person to pre-store a location independent parameter in memory, because the state of the ROEF is completely dependent on the physical location of the device.

Thus, the proposed combination does not create a suggestion or motivation to combine since the "location independent" parameter that the present claims store in memory is associated with a geographic characteristic, and in Schmidt, there is a

teaching away from such a parameter because as the device moves, the allowance or disallowance of a call changes. For at least these reasons, there is no suggestion or motivation to combine Schmidt with Irvin.

2. Reasonable Expectation of Success

Further, the Examiner has not demonstrated that the modification of the cited references points to the reasonable expectation of success in the present claims, which is the second requirement of the obviousness analysis.

For example, Schmitt does not describe that a "location independent" parameter associated with the geographic characteristic is stored in the memory and "indicates that the geographic characteristic is an approved geographic characteristic." (See claims 41, 46, and 49, although the wording varies slightly between each of these claims). Similarly, Irvin only deals with using location sensing systems to determine whether a device is in a safe zone. Even if Schmidt could be combined with Irvin, there is no expectation that either of these disclosures could be combined and used with the above claimed "location independent parameter" because such a parameter (as taught by the combination of Schmidt and Irvin) would give erroneous results in a high percentage of instances depending on the location of the device.

For example, the parameter might indicate that a certain geographic characteristic is not approved. If Schmidt were capable of using such a parameter and the owner of the device was located near their home base station they would not be able to make a call even though they are not roaming. Similarly, the parameter might indicate that a certain geographic characteristic is approved. If Schmidt were capable of

using such a parameter and the owner of the device traveled to the other side of the globe, they would be able to make a call even though they were roaming.

From the teachings of Irvin and Schmidt, therefore, the combination fails in its intended purpose to restrict calls while roaming, if it were to have a location independent parameter in memory associated with a geographic characteristic to indicate whether the characteristic is approved because such an approval in Schmidt is related to the location of the device. On the contrary, the presently claimed parameter is not associated with the physical location of the device.

3. Combined References Must Teach All Claim Limitations

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of the claims. For example, the present independent claims 41, 46, and 49 include the limitations of "utilizing a controller to determine if a parameter associated with the geographic characteristic stored in the memory indicates that the geographic characteristic is an approved geographic characteristic, the parameter being independent of the physical location of the wireless communication device," (claim 41), "a memory for storing at least one area code, a location independent parameter associated with the at least one area code, and at least one authorized location," (claim 46), and a memory for storing a geographic characteristic, a parameter associated with the geographic characteristic, and an authorized location, "wherein the parameter is not dependent on the current physical location" of the device. (claim 49).

Schmidt and Irvin do not teach, suggest, or describe these limitations. Irvin is cited for teaching determining a physical location of a device. Schmidt associates a state machine with a physical location of a device to restrict calls while roaming. Thus, even if the state machine is a "parameter" it is not associated with a geographic characteristic or area code stored in memory and it is not location independent. Instead, it is associated with a physical location of a device (i.e., close or far from home base station).

Since the combination of references does not include all the limitations of claims 41-54, the Applicant requests that the rejection be withdrawn.

4. Effect of KSR

After the recent Supreme Court decision in the KSR case, although it is clear that the above analysis using the Federal Circuit's teaching-suggestion-motivation test is not the only way to approach the obviousness inquiry, it remains a useful tool in the obviousness inquiry. However, even if an alternative tool is employed as part of the obviousness inquiry, it is clear from KSR that any combination of references in an obviousness rejection must provide reasonable inferences that are based on substantial evidence in the record. Here, no such substantial evidence has been identified and therefore even after KSR, Applicant asserts that the pending claims are not obvious in view of the prior art of record.

(2) Schmidt (U.S. Patent No. 6,208,872) and in view of Agness et al. (U.S. Patent No. 6,799,052)

The Examiner rejects claims 41, 46, and 49 as being unpatentable over Schmidt in view of Agness et al. (United States Patent No. 6,799,052). In light of the arguments contained herein, the Applicants respectfully request that this rejection be withdrawn.

With regard to independent claim 41, 46, and 49 the Examiner states that Schmidt teaches all of the elements of the claims, except utilizing a GPS functional device. The Examiner further states that Agness teaches this limitation. The Examiner states that the combination of Schmidt and Agness makes the claims obvious. This rejection is traversed as follows.

The combination of Schmidt and Agness teaches away from the present claims. For example, if the combination of Schmidt and Agness taught the "parameter" associated with the "geographic characteristic" in memory, the parameter would indicate one of two things, either the call is allowed or it is not allowed. If the parameter says the call was allowed and in Schmidt, the device user traveled far from their home station, then the call would be allowed while roaming. Since this is contrary to Schmidt, it motivates a person to store a parameter that depends on the location of the device. For that reason, there is no motivation to combine Schmidt with Agnes to achieve the present claims.

Moreover, since Agness is completely silent as to an examination of the outgoing number or the incoming number to see if the numbers match a geographic characteristic the combination is even less likely to create a motivation to combine to achieve the present claims, which do not depend on the device's location.

Also, even if Schmidt could be combined with Agness, there is no expectation that either of these disclosures could be combined and used with the above claimed "location independent parameter" because such a parameter (as taught by the combination of Schmidt and Agness) would give erroneous results in a high percentage of instances depending on the location of the device. Moreover, any parameter associated with Agness is completely dependent on the location of the device and whether it is currently located in an "inhibit zone." As such, the combination of Schmidt and Agness does not produce a reasonable expectation of success.

Finally, Schmidt in view of Agness does not yield all the limitations of the claims. Agness is cited for teaching determining a physical location of a device. Schmidt associates a state machine with a physical location of a device for the purpose of restricting calls while roaming. Thus, even if the state machine is a "parameter" it is not associated with a geographic characteristic or area code stored in memory and it is not location independent. Instead, it is associated with a physical location of a device (i.e., close or far from home base station). Since the combination of references does not include all the limitations of claims 41, 46, and 49, the Applicant requests that the rejection be withdrawn.

B. Conclusion

For all the foregoing reasons, allowance of claims 41-54 pending in the present application is respectfully requested. If necessary, applicant requests, under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above-identified application and to charge the fees for a large entity under 37 CFR 1.17(a).

The Director is authorized to charge any additional fee(s) or any underpayment of fee(s) or credit any overpayment(s) to Deposit Account No. 50-3001 of Kyocera Wireless Corp.

Respectfully Submitted,

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